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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,459	09/26/2001	John N. Feder	D0039NP	5268

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EXAMINER

ULM, JOHN D

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 02/03/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/966,459

Applicant(s)
Feder et al.

Examiner
John Ulm

Art Unit
1646



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-34 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other: |

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Claims 1 to 34 are pending in the instant application.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 to 10, 14, 15, 20 and 27, drawn to an isolated nucleic acid, vector, host cell and method of use, classified in class 435, subclass 69.1.
- II. Claims 11, 12, 16, 27 and 28, drawn to an isolated polypeptide, classified in class 530, subclass 350.
- III. Claim 13, drawn to an antibody which binds to a receptor protein, classified in class 530, subclass 388.22.
- IV. Claims 17 and 26, only in so far as they relate to a method of treatment by administering a polypeptide, classified in class 514, subclass 2.
- V. Claim 17, only in so far as it relates to a method of treatment by administering a polynucleotide, classified in class 514, subclass 44.
- VI. Claim 18, drawn to a method of genetic diagnosis, classified in class 435, subclass 6.
- VII. Claim 19, drawn to a method of diagnosis by detecting the expression of a protein in an individual, classified in class 436, subclass 536.
- VIII. Claims 21 to 23 and 25, drawn to a receptor binding assay employing a recombinant host cell, classified in class 435, subclass 7.21.
- IX. Claim 24, drawn to a compound of unspecified constitution, classification undeterminable.

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- X. Claim 29, drawn to a cell comprising NFAT/CRE and a receptor polypeptide, classified in class 435, subclass 252.3.
- XI. Claim 30, drawn to a cell comprising NFAT G alpha 15 and a receptor polypeptide, classified in class 435, subclass 252.3.
- XII. Claims 31 to 34, drawn to a receptor activation assay, classified in class 436, subclass 501.

The inventions are distinct, each from the other because:

The polynucleotide of invention I, the polypeptide of invention II, the antibody of invention III, the compound of invention IX, and the cells of inventions XI and XII are chemically and structurally different compounds and compositions each of which can be made and used without the others. The cells of inventions XI and XII do not use the "isolated" polypeptide of invention II. The claims, as written, encompass a cell which naturally express the polypeptide referred to therein.

The nucleic acid of invention I is related to each the processes of inventions V, VI and VIII as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a plurality of materially different process including a process of making a protein, a binding assay employing a recombinant cell, a method of treatment and a method of

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diagnosis, all of which are claimed. The four claimed processes are materially different because they have different methods steps, different modes of operation and different objectives.

The cell of invention X and the cell of invention XI are each related to the process of invention XII as product and process of use. They are shown to be distinct because the process, as claimed, can be practiced with the two materially different products that are inventions X and XI.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

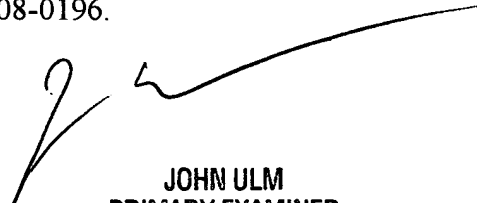
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm whose telephone number is (703) 308-4008. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

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Official papers filed by fax should be directed to (703) 308-4242 or (703) 872-9306.
Official responses under 37 C.F.R. § 1.116 should be directed to (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

A handwritten signature in black ink, appearing to read 'J. ULM', with a long horizontal flourish extending to the right.

JOHN ULM
PRIMARY EXAMINER
GROUP 1800